

## II. Information Disclosure Statement

Applicants filed an Information Disclosure Statement on June 19, 2001.

On the copy of the PTO Form 1449 returned to Applicants with the present Office Action, the Examiner did not initial the citation of Revlon Colorstay®'s product label. Accordingly, Applicants respectfully request that the Examiner consider this document and sign off on this document as being considered.

## III. Rejections under 35 U.S.C. § 112, Second Paragraph

In order to meet the requirements of 35 U.S.C. § 112, second paragraph, the claims must define the patentable subject matter with a reasonable degree of particularity and precision. M.P.E.P. § 2173.02 (emphasis in original). The Federal Circuit has decided that the definiteness of the claim language must be analyzed, not in a vacuum, but in light of the content of the application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *Id.* The definiteness of a claim is an objective inquiry which evaluates whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art. See e.g., M.P.E.P. § 2171.

**Claims 16, 31, 50, 85, 99, and 118**

Claims 16, 31, 50, 85, 99, and 118 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner asserts that “[t]he expression ‘spherical compounds’ is ambiguous and unclear” and that “[r]ecourse to the specification does not describe the spherical compounds.” See page 2 of the present Office Action. Applicants respectfully disagree and traverse this rejection.

Applicants direct the Examiner's attention to paragraph 070 at page 24 of the specification as originally filed. This paragraph describes and provides examples of spherical compounds. Accordingly, when the definiteness of the rejected claim language is properly analyzed, not in a vacuum, but in light of the content of the application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made, the expression “spherical compounds” defines the patentable subject matter with the requisite reasonable degree of particularity and precision. Accordingly, Applicants request that this rejection be withdrawn.

**Claims 16, 31, 50, 85, 99, and 118**

Claims 16, 31, 50, 85, 99, and 118 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner asserts that “[t]he expression ‘biological materials’ is ambiguous and unclear” and that “[r]ecourse to the specification does not describe the biological materials.” See page 2 of the present Office Action. Applicants respectfully disagree and traverse this rejection.

The term “biological materials” is a term of art. For example, Hawley’s Condensed Chemical Dictionary, Thirteenth Edition, defines “biologicals” at page 140 as “[m]edical products produced from living organisms or their products. These include antigens, antitoxins, serums, and vaccines.” Accordingly, when the definiteness of the rejected claim language is properly analyzed, not in a vacuum, but in light of the content of the application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made, the expression “biological materials” defines the patentable subject matter with the requisite reasonable degree of particularity and precision. Accordingly, Applicants request that this rejection be withdrawn.

**Claims 16, 31, 50, 85, 99, and 118**

Claims 16, 31, 50, 85, 99, and 118 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner asserts that the expression "derivatives of any of the foregoing" is without metes and bounds. See pages 2-3 of the present Office Action.

Applicants respectfully disagree and traverse this rejection.

Applicants submit that the metes and bounds of the rejected claims are defined with the requisite reasonable degree of particularity and precision such that they would have been clear to one of ordinary skill in the art. For example, The American Heritage College Dictionary (Third Edition) defines the verb "derive" as "4. *Chem.* To produce or obtain (a compound) from another substance by chemical reaction." Further, The American Heritage College Dictionary (Third Edition), defines "derivative" as "[a] compound derived or obtained from another and containing the essential elements of the parent substance." Thus, one of ordinary skill in the art would recognize that, according to the rejected claims, at least one additional ingredient may be chosen from the recited ingredients and compounds produced or obtained from the recited ingredients which contain the essential elements of the recited ingredients.

Accordingly, when the definiteness of the rejected claim language is properly analyzed, not in a vacuum, but in light of the content of the application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made, the expression "and derivatives of any of the foregoing" defines the patentable subject matter with the requisite reasonable degree of particularity and precision. Accordingly, Applicants request that this rejection be withdrawn.

**Claim 102**

Claim 102 is rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner asserts that the claim recites "chosen from" yet recites one copolymer. See page 3 of the present Office Action. Applicants respectfully disagree and traverse this rejection.

Claim 102 recites that at least one of the at least two film formers of claim 101 is chosen from allyl stearate/vinyl acetate copolymer film formers. The term "allyl stearate/vinyl acetate copolymer film formers" comprises a class of copolymers derived from allyl stearate and vinyl acetate units. Accordingly, there

may be different types of allyl stearate/vinyl acetate copolymer film formers, such as, for example, block copolymers and graft copolymers. Accordingly, the phrase "chosen from" is proper and Applicants request that this rejection be withdrawn.

#### IV. Rejections Under 35 U.S.C. § 102(e)

A rejection under § 102 is only proper when the claimed subject matter, in this case a composition, is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); *see also* M.P.E.P. § 706.02(a) ("For anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly.").

#### US '306

Claims 1-14, 16-29, 31-45, 47-60, 62-80, and 82-119 are rejected under 35 U.S.C. § 102(e) as unpatentable over U.S. Patent No. 6,423,306 B2 ("US '306") for the reasons set forth on pages 3-4 of present Office Action. Applicants respectfully disagree and traverse this rejection.

The Examiner asserts that trimethyl siloxy silicate, exemplified in Example 1 of US '306, reads on the presently claimed polymethylsilsesquioxane.

However, as explained in the specification as originally filed, for example, at

page 4, paragraphs 016 and 017, trimethylsiloxysilicate is a siloxysilicate comprising MQ units, whereas polymethylsilsesquioxanes are silsesquioxanes comprising T units. MQ units are a distinctly different type of silicone unit than T units. See e.g., structures on pages 2-4 of the specification as originally filed. Nowhere does *US '306* teach or suggest polymethylsilsesquioxanes, let alone polymethylsilsesquioxane film formers comprising repeating units of formula  $(\text{CH}_3\text{SiO}_{3/2})_x$ , i.e. T units, as presently claimed.

As a rejection under § 102 is only proper when the claimed subject matter is identically described or disclosed in the prior art, the rejection over *US '306* is improper. Accordingly, Applicants respectfully request withdrawal of this rejection.

**US '782**

Claims 1-12, 14, 16, 32-45, 47, 49-60, 62, 64, 65, 86-94, 96-100, 104-114, and 116-118 are rejected under 35 U.S.C. § 102(e) as unpatentable over U.S. Patent No. 6,045,782 ("*US '782*") for the reasons set forth on pages 4-5 of present Office Action. Applicants respectfully disagree and traverse this rejection.

As with *US '306* discussed above, *US '782* fails to teach or suggest polymethylsilsesquioxanes. In the present rejection, the Examiner asserts that

diisostearoyl trimethylolpropane siloxysilicate, exemplified in Example 3 of *US '782*, reads on the presently claimed polymethylsilsesquioxanes. As discussed above, siloxysilicates are different than silsesquioxanes. Nowhere does *US '782* teach polymethylsilsesquioxanes, let alone polymethylsilsesquioxane film formers comprising repeating units of formula  $(\text{CH}_3\text{SiO}_{3/2})_x$  as presently claimed.

As a rejection under § 102 is only proper when the claimed subject matter is identically described or disclosed in the prior art, the rejection over *US '782* is improper. Accordingly, Applicants respectfully request withdrawal of this rejection.

**V. Rejection Under 35 U.S.C. § 103(a)**

Claims 1-66, 70-101, and 104-118 are rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,071,503 ("*US '503*") in view of U.S. Patent No. 5,959,009 ("*US '009*") and U.S. Patent No. 5,756,082 ("*US '082*") for the reasons set forth on pages 5-6 of present Office Action. Applicants disagree and respectfully traverse this rejection.

Two of the basic criteria an Examiner must demonstrate in order to establish a prima facie case of obviousness are (1) that the prior art reference (or references when combined) teach or suggest all the claim limitations, and (2) that there is some suggestion or motivation, either in the references themselves



or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See M.P.E.P. § 2143. Neither of these two criteria has been satisfied with respect to the modifications of *US '503* proposed by the Examiner.

*US '503* discloses cosmetic compositions comprising a combination of organosiloxane resins and fluid diorganosiloxane resins with a volatile carrier. See Abstract. The Examiner relies on *US '503* for the teaching of "transfer resistant cosmetic compositions using components 1 ['polymethylsilsesquioxane'], 3 ['various additives'], and 4 ['emollients, thickening agents, and UV absorbers']." See pages 5-6 of the present Office Action. The Examiner concludes that *US '503* "does not teach [component] 2 ['film former, which is different than [polymethylsilsesquioxane]']." *Id.* However, contrary to the Examiner's implication that *US '503* satisfies all elements of the present claims other than the at least one film former different than the at least one polymethylsilsesquioxane film former, *US '503* does not teach or suggest at least the presently claimed at least one polymethylsilsesquioxane film former.

The Examiner cites col. 7, lines 20-50 for the teaching of polymethylsilsesquioxanes. *Id.* However, the cited portion of *US '503* states that "[t]he organosiloxane resins used in the...invention comprise combinations of..."M" units,... "D" units,... "T" units, [and]..."Q" units." See col. 7, lines 23-25.

In contrast, the presently claimed at least one polymethylsilsesquioxane film former comprises repeating "T" units (i.e., units of formula  $(\text{CH}_3\text{SiO}_{3/2})_x$ ) and may optionally comprise up to 1% of "D" units (i.e., units of formula  $((\text{CH}_3)_2\text{SiO}_{2/2})_x$ ). See e.g., page 4, paragraphs 016-018, 041-049, and claims 1 and 8. Thus, *US '503* does not teach the polymethylsilsesquioxane film formers of the present invention.

Moreover, there is no motivation to modify the organosiloxanes of *US '503* to a polymethylsilsesquioxane film former of the present invention. The Examiner must consider the teachings of references "in their entirety, i.e., as a whole, including portions that would lead away from the claimed invention."

M.P.E.P. §2141.02 (emphasis in original). "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be . . . led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). In the present case, one of ordinary skill in the art would be led in a direction divergent from selecting the presently claimed at least one polymethylsilsesquioxane film former comprising repeating units of formula  $(\text{CH}_3\text{SiO}_{3/2})_x$ , as *US '503* actually teaches away from doing so. *US '503* teaches that "[p]articularly preferred are resins comprising repeating... 'M' units and... 'Q' units, otherwise known as 'MQ' resins." See col. 7, lines 34-37. Moreover, each of the twenty-four exemplified compositions in *US*

'503 comprises MQ resin as the organosiloxane resin. See Examples 1-24.

Accordingly, one of ordinary skill in the art would be led in a direction divergent from using the presently claimed at least one polymethylsilsesquioxane film former comprising repeating units of formula  $(\text{CH}_3\text{SiO}_{3/2})_x$ , and therefore, there would not have been the requisite suggestion or motivation to modify the reference in such a manner as to read on the presently claimed polymethylsilsesquioxane film former.

The Examiner relies on *US '009* and *US '082* only to cure the asserted deficiency in *US '503*, i.e., the lack of teaching of at least one film former different from the at least one polymethylsilsesquioxane film former. As neither *US '009* nor *US '082* teach or suggest at least one polymethylsilsesquioxane film former comprising repeating units of formula  $(\text{CH}_3\text{SiO}_{3/2})_x$ , the cited references, when combined, fail to teach or suggest all the claim limitations.

Accordingly, at least because *US '503* teaches away from the presently claimed at least one polymethylsilsesquioxane film former comprising repeating units of formula  $(\text{CH}_3\text{SiO}_{3/2})_x$  and because neither *US '009* nor *US '082* teach or suggest such polymethylsilsesquioxane film formers, the combination of *US '503*, *US '009*, and *US '082* fails to render the presently claimed compositions obvious.

In light of the foregoing, Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness, and thus, request that the rejections under 35 U.S.C. § 103(a) be withdrawn.

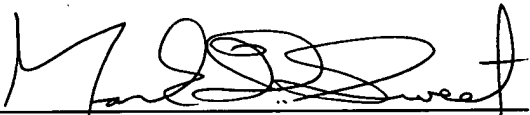
**VI. Conclusion**

In view of the foregoing remarks, Applicants respectfully request the reconsideration of the pending claims, reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON,  
FARABOW, GARRETT & DUNNER, L.L.P.

By:   
Mark D. Sweet  
Reg. No. 41,469

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FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com